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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,187	04/19/2001	Dwayne D. Leismer	68.0181	1534

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EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT	PAPER NUMBER
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3672

10

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,187

Applicant(s)

LEISMER, DWAYNE D.

Examiner

Zakiya N. Walker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,6,8-16,21-27,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,6,8-16,21-27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

The final rejection mailed 1/24/03 (paper #6) has been vacated, and the period for response has been restarted accordingly.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hydraulically driven cutter of claim 27 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 30 is objected to because of the following informalities: in line 3, the term "sheared" should be replaced with --cut-- for consistent terminology purposes.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 3, 4, 8-16, 21-25, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Borg (cited by applicant).

Borg discloses an umbilical safety joint 18 that includes a first member 30, a second member 32, a control line shear mechanism 34-37 proximate an interface (surface forming common boundary between members), a first shear member 34, a second shear member 36, and a control line 14. The reference further teaches the shear mechanism integral to the members, a release mechanism (shear element 24), a control line passageway (slots within members, and a recess), the first and second shear members attached to first and second tubular members, the control line passageway comprising a pair of shearing blades 34, 36, and the control line passageway positioned at an angle (see Fig. 1). The method teaches separating a first member from a second member, before or during the separating step, cutting a control line, members comprising a safety joint, two segments of tubular string 28, the safety joint comprises a control line cutting mechanism, and the separation of first and second members is independent of cutting. With respect to method claims 29 and 30, the reference teaches providing a string with a safety sub 18, attaching a control line, inserting the string, separating the string at the safety sub, cutting the control line, and removing the upper portions of the string and control line.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borg alone.

Borg discloses an umbilical safety joint as stated above. However, the reference fails to teach a solenoid or hydraulically driven cutter as called for in the claimed combination or method. It is well known to actuate downhole devices using mechanical, hydraulic, pneumatic, or solenoid driven devices. It would be considered an obvious design choice to adapt a downhole tool to be driven by any of the known actuation methods. Therefore, it would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have substituted the mechanical/tension driven cutter with a solenoid or hydraulically driven cutter in order to provide for alternate forms of actuation, suited for the particular work environment.

Response to Arguments

7. Applicant's arguments with respect to claims 3, 4, 6, 8-16, 21-27, 29, and 30 have been considered but are moot in view of the new ground(s) of rejection.

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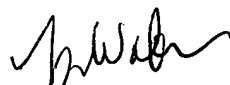
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pringle'411 (cited by applicant) teaches a downhole cutting tool driven by hydraulic and pneumatic means. Pringle et al.'663 (cited by applicant) and Sizer et al. teach downhole apparatus driven by solenoid means.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Monday-Thursday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 746-3826 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.


Zakiya N. Walker
Examiner
Art Unit 3672

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May 7, 2003